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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,638	09/18/2003	William J. Borland	EL0499 US NA	5044
23906	7590	10/05/2005	EXAMINER	
E I DU PONT DE NEMOURS AND COMPANY LEGAL PATENT RECORDS CENTER BARLEY MILL PLAZA 25/1128 4417 LANCASTER PIKE WILMINGTON, DE 19805			HA, NGUYEN T	
			ART UNIT	PAPER NUMBER
			2831	

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,638

Applicant(s)

BORLAND ET AL.

Examiner

Nguyen T Ha

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 13-19 and 21 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 13-19 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi (US 6,266,226) in view of Kunishi et al. (US 5,227,960).

Regarding claim 13, Hayashi discloses a capacitor (1A-1B & 2A-2B) comprising:

- a first electrode/lower electrode (11) comprising a first plurality of electrode portions/element electrodes (15);

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- a first dielectric (13) over the first electrode; and
- a second electrode/upper electrode (12) formed over the first dielectric.

Hayashi lacks the second electrode formed from a metallic foil.

Kunishi et al. teach a second electrode (column 3, lines 57-59).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the Kunishi et al. electrode in Hayashi in order to produce high resistance and capacitance for capacitor, and suitable to apply in the capacitor.

Regarding claim 14, Hayashi further discloses the dielectric material (13) that contacts and substantially encases the capacitor (figure 1A).

Regarding claim 15, Hayashi discloses one or more of the first plurality of electrode portions (15) are trimmed to achieve a target capacitance value (figure 1B).

Regarding claim 16, Hayashi discloses a capacitor (figures 1A-1B & 2A-2B) comprising:

- a first electrode/lower electrode (11) comprising a first plurality of electrode portion/element electrode (15);
- a second electrode/upper electrode (12) comprising a second plurality of electrode portions/element electrode (16) spaced from an inter-digitated with the first plurality of electrode portions (figure 1A); and
- a dielectric (13) disposed between the first and second plurality of electrode portions.

Hayashi lacks the first and second electrodes are formed from a metallic foil.

Kunishi et al. teach a second electrode (column 3, lines 57-59).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the Kunishi et al. electrode in Hayashi in order to produce high resistance and capacitance for capacitor, and suitable to apply in the capacitor.

Regarding claim 17, Hayashi further discloses the dielectric material that contacts and substantially encases the capacitor (figure 1A).

Regarding claim 18, Hayashi discloses one or more of the first plurality of electrode portions (15) are trimmed to achieve a target capacitance value (figure 1B).

Regarding claim 19, Hayashi disclose the first plurality of electrode portions (15) comprises at least four electrode portions (figure 1B).

Regarding claim 21, Hayashi discloses a printed wiring board containing the capacitor (column 2, lines 36-37).

Regarding claim 22, Hayashi discloses the plurality of electrode portions comprises at least four electrode portions (figure 7).

Regarding claim 23, Hayashi discloses the metallic foil comprises copper (column 6, lines 1, and 39-40).

Regarding claim 25, Hayashi discloses the metallic foil comprises copper (column 6, line 1, and lines 39-40).

Regarding claim 24, the teaching of Kunishi includes a third electrode and second dielectric disposed on the second electrode, wherein the second electrode is isolated from the first and third electrodes, and wherein the first and third electrodes are separated from the second electrode by the first and second dielectric which forms a two layer dielectric (figures 1-2).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nguyen T. Ha whose telephone number is 571-272-1974. The examiner can normally be reached on Monday-Friday from 8:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on 571-272-2800 ext. 31. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Nguyen T. Ha', with a long horizontal flourish extending to the right.

Nguyen T. Ha
October 3, 2005